

REMARKS

I. Status of the Claims

Claims 3, 5, 13, and 44-59 are pending. Claims 1-2, 4, 6-12, and 14-43 were previously canceled without prejudice or disclaimer. Claims 56 and 57, drawn to withdrawn claims, are canceled herewith, purely to help expedite an allowance. Applicants reserve the right to file one or more continuing applications to the canceled subject matter. Claims 3 and 13 are amended and claims 58 and 59 are added for the reasons set forth below.

Claim 3 is amended to further characterize the [T-DNA border-like] sequence that flanks the desired polynucleotide. Accordingly, Applicants clarify that the sequence is “25 nucleotides in length” and that it functionally (b) promotes and facilitates integration of the desired polynucleotide into the plant genome and which (c) is not 100% identical to a T-DNA border, and wherein (d) the 25 nucleotide-long sequence comprises (i) a plant DNA sequence that comprises the consensus nucleotide sequence of any one of SEQ ID NOs. 47, 93, 113, 115, and 117, or (ii) a nucleotide sequence that has at least 70% sequence identity to the consensus sequence of (i).” Claim 13 is amended in the same fashion. The consensus sequences are fully supported by the specification. See, for instance, the sequence listing, original claim 2, paragraphs 219 and 333, and Table 2 of the specification. See also paragraphs 47 and 53 for the percentage sequence identity variation. Examiner Fox acknowledges the written description support and enablement of sequences that are 25 nucleotides in length. Please see page 2, lines 21-22.

New claim 58 is added to cover a nucleotide sequence that has point mutations within its 25 nucleotide long, consensus-containing sequence. See paragraph 262 of the specification for explicit support (“[I]t may also be efficacious to introduce point mutations at the terminal sequences to render the P-DNA more effective in transferring DNA”; the terminal sequences of the plant-derived T-DNA (P-DNA) are the border-like sequences). Claim 59 is added to cover a progeny plant obtained from the plant of claim 3.

Since none of these amendments or added embodiments introduces new matter, Applicants respectfully request their entry into the record.

Applicants acknowledge Examiner Fox's statement that the amendments and arguments they filed on February 20, 2007 "have overcome the outstanding indefiniteness and new matter rejections" (page 2) but that certain other rejections are maintained. Applicants believe that the amended claims address and overcome these remaining rejections for the reasons that follow below.

II. The claims recite a genus of sequences falling under a consensus sequence and are therefore supported by the written description

Claims 3, 5, 13, and 44-55 are rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Office action at pge 2. Examiner Fox had previously concluded that there is "no particular consensus sequence of any length" recited in the claims and that "the claims do not recite a genus of sequences which is commensurate in scope with what was exemplified." Please see page 4 of the office action dated November 20, 2007.

Applicants appreciate Examiner Fox's perspective but do not acquiesce with the stated rationales. To expedite examination and to help advance this case toward allowance, however, Applicants have amended the claims to recite sequences of a particular length (25 nucleotides) and a particular consensus sequence, as denoted by sequence identifiers 47, 93, 113, 115, and 117, recited in the claim, and clarify that these sequences are not 100% identical to a T-DNA border. Written description support for these consensus sequences is found explicitly in the specification as Applicants pointed out in the preceding subsection. Functionally, these sequences, or the claimed variants thereof, must be able to promote and facilitate the integration of the desired polynucleotide into the plant genome.

Applicants believe that these amendments fully characterize the claimed sequence in terms of its length, its core or underlying consensus sequence, its dissimilarity to known Agrobacterium T-DNA borders, and its functionality. All of these embodiments were written in the specification and in Applicants' possession at the time of filing. For these reasons, Applicants believe that the written description rejection is moot and respectfully request its withdrawal.

III. The claims recite the length and underlying consensus sequence for the integrative nucleotide sequence and are enabled

Claims 3, 5, 13 and 44-55 are rejected under 35 U.S.C. § 112, first paragraph as allegedly non-enabled for claims broadly drawn to any sequence of any length for transferring foreign DNA into heterologous plants. Office action at pages 2-3. Examiner Fox acknowledges that the claims are enabled “for claims limited to methods of using 25 base pair-long P-DNA borders from plants comprising the consensus sequence of SEQ ID NO: 47.” *Id.*

Applicants respectfully disagree with that proposition, but believe that the claims, as amended to qualify the length of the “border” sequence as 25 base pairs-long and to recite any one of four consensus sequences, renders this rejection moot. Applicants believe that the recitation of the length and underlying consensus sequence in the claims are enabled and therefore request withdrawal of this rejection.

IV. McElroy does not anticipate claim 13

Claim 13 is rejected under 35 U.S.C. § 102(e) as allegedly anticipated by United States Patent No. 6,750,379 (“McElroy”). Office action at page 5. Basically, the Office’s position is that “claim 13 does not stipulate that the 5-100 nt portion of the integrative sequence not be identical to a T-DNA border sequence.” *Id.*

Applicants believe that the way they have amended claim 13 addresses this comment directly. That is, Applicants clarify that the integrated “desired polynucleotide” comprises a sequence that is “not 100% identical to a T-DNA border.” When combined with the recited 25 nucleotide length of that sequence, it becomes clear that McElroy cannot anticipate claim 13. McElroy does not teach any such sequence as that recited by the present claims. Thus, McElroy does not teach each and every element of the claimed invention and therefore Applicants respectfully assert that McElroy is not 102(e) prior art and respectfully request withdrawal of this rejection.

CONCLUSION

Applicants believe that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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